

Remarks/Arguments

A. Pending Claims

Claim 60 has been amended. Claims 60-63, 65, 68-75, 79-82, 84, 87-97, 99, and 102-108 are pending in the case.

B. The Claims Are Not Obvious Over Peterson in View of Reed Pursuant To 35 U.S.C. § 103(a)

The Examiner rejected claims 60-63, 65, 68-75, 79-82, 84, 87-97, 99, and 102-108 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,343,271 to Peterson et al. (hereinafter "Peterson") in view of U.S. Patent No. 5,862,325 to Reed et al. (hereinafter "Reed"). Applicant respectfully disagrees with the rejections.

To reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner*, 154 U.S.P.Q. 173, 177-78 (C.C.P.A. 1967). To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); MPEP § 2143.03.

Amended claim 60 describes a combination of features including:

- automatically determining a table of contents based at least in part on input received regarding the first insurance claim processing step;
- automatically displaying the table of contents on the display device, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps

Applicant respectfully submits that this feature is not taught or suggested by the cited art.

The Office Action takes the position that Peterson discloses the above-quoted feature of

claim 60. Applicant respectfully disagrees with this position. Peterson discloses a communications infrastructure that allows health care providers and patients to login and access benefits information from a claims processing system (Peterson, column 7, lines 18-20; column 8, lines 44-47). The health care provider may receive claim forms and submits claims through an access terminal (Peterson, column 9, lines 18-20). The claims may be transferred to an adjudication system for automatic adjudication or manual adjudication (Peterson, column 9, lines 25-60). Peterson does not appear to teach or suggest automatically determining a table of contents based at least in part on input received regarding the first insurance claim processing step and automatically displaying the table of contents including an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step and one or more additional insurance claim processing steps.

Amended claim 60 also describes “automatically adding or deleting one or more steps from the table of contents in response to the received input from the first or second insurance claim processing step or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first or second insurance claim processing step.” Applicant respectfully submits that this feature is not taught or suggested by the cited art.

The Office Action acknowledges that Peterson does not teach the above-quoted feature of claim 60. Nevertheless, the Office Action asserts that Reed suggests the above-quoted feature of claim 60. Applicant respectfully disagrees with this assertion. Reed discloses using html elements in the display of communications content between providers and consumers (Reed, column 18, lines 62-67). The html elements can be filtered, sorted, and displayed by a consumer program. (Reed, column 19, line 16-19). A method may generate input forms for gathering additional data from a consumer (Reed, column 73, line 65 to column 74, line 18). Reed does not appear to teach or suggest automatically adding or deleting one or more steps from a table of contents in response to the received input from the first or second insurance claim processing step or automatically modifying the sequence of processing steps listed in the table of contents in

response to the received input from the first or second insurance claim processing step.

Moreover, Applicant respectfully submits that the Office Action has not stated a *prima facie* case of obviousness for combining Peterson with Reed to include the above-quoted features of claim 60. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Applicant respectfully submits that “providing program which can be used to create, edit, and maintain data, metadata and instructions in a provider database” does not provide a motivation to combine Peterson with Reed to include the several features of claim 60 quoted above.

Applicant submits that, for at least the reasons provided above, claim 60 and the claims depending from claim 60 are patentable over the cited art. Applicant therefore respectfully requests the removal of the 35 U.S.C. §103(a) rejections of these claims.

Applicant submits that claims dependent on claim 60 are independently patentable. For example, claim 73 describes a combination of features including: “wherein insurance claim processing steps are associated with table of contents properties, and wherein determining the table of contents comprises determining insurance claim processing steps that are associated with the table of contents properties.” Applicant respectfully submits that this feature is not taught or suggested by the cited art.

The Office Action asserts that Reed discloses the above quoted feature of claim 73. Applicant respectfully disagrees with this assertion. Reed discloses generating an input form that includes fields for manual input from a consumer (Reed, column 74, line 3-7). The input form can display data already present in a consumer database for confirmation and authorization by the

consumer (Reed, column 74, line 3-7). Reed does not appear to teach or suggest insurance claim processing steps associated with table of contents properties, wherein determining the table of contents includes determining insurance claim processing steps that are associated with the table of contents properties.

Claim 74 describes a combination of features including: “wherein insurance claim processing steps are associated with table of contents properties, wherein determining the table of contents comprises determining insurance claim processing steps that are associated with the table of contents properties, and wherein the table of contents properties comprises a condition which specifies when an associated insurance claim processing step should be included in the table of contents.” Applicant respectfully submits that this feature is not taught or suggested by the cited art.

The Office Action asserts that Reed discloses the above quoted feature of claim 74. Applicant respectfully disagrees with this assertion. Reed discloses generating an input form that includes fields for manual input from a consumer (Reed, column 74, line 3-7). The input form can display data already present in a consumer database for confirmation and authorization by the consumer (Reed, column 74, line 3-7). Reed does not appear to teach or suggest insurance claim processing steps associated with table of contents properties, wherein determining the table of contents includes determining insurance claim processing steps that are associated with the table of contents properties and wherein the table of contents properties include a condition which specifies when an associated insurance claim processing step should be included in the table of contents.

Claim 75 describes a combination of features including: “displaying the table of contents on a display device coupled to the computer system, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim” and “automatically adding or deleting one or more steps from the table of contents in response to the received input from the selected insurance claim processing step or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the selected

insurance claim processing step.” For at least the reasons described above with respect to claim 60, Applicant submits that claim 75 and the claims dependent from claim 75 are patentable over the cited art. Applicant respectfully requests removal of the rejection of claim 75 and claims dependent thereon.

Claim 79 describes a combination of features including: “automatically determine a table of contents in response to input received regarding the first insurance claim processing step; automatically display the table of contents, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps” and “automatically add or delete one or more steps from the table of contents in response to the received input from the first or second insurance claim processing step or automatically modify the sequence of processing steps listed in the table of contents in response to the received input from the first or second insurance claim processing step.” For at least the reasons described above with respect to claim 60, Applicant submits that claim 79 and the claims dependent from claim 79 are patentable over the cited art. Applicant respectfully requests removal of the rejection of claim 79 and claims dependent thereon.

Claim 94 describes a combination of features including: “automatically determining a table of contents based at least in part on input received regarding the first insurance claim processing step; automatically displaying the table of contents, wherein the table of contents comprises an ordered list of the steps associated with the processing of the insurance claim, and wherein the ordered list of steps comprises the first insurance claim processing step, and one or more additional insurance claim processing steps” and “automatically adding or deleting one or more steps from the table of contents in response to the received input from the first or second insurance claim processing step or automatically modifying the sequence of processing steps listed in the table of contents in response to the received input from the first or second insurance claim processing step.” For at least the reasons described above with respect to claim 60, Applicant submits that claim 94 and the claims dependent from claim 94 are patentable over the

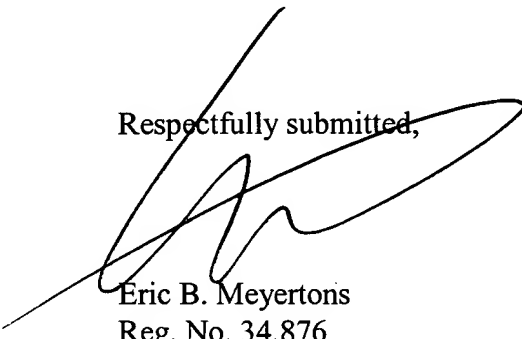
cited art. Applicant respectfully requests removal of the rejection of claim 94 and claims dependent thereon.

C. Additional Remarks

Based on the above, Applicant submits that all claims are in condition for allowance. Favorable reconsideration is respectfully requested.

If any extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-27600/EBM.

Respectfully submitted,



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